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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
BIANCHI, KRISTIN A	

ART UNIT	PAPER NUMBER
1626	

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01/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/578,403	FISCHER ET AL.	
	Examiner	Art Unit	
	KRISTIN BIANCHI	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8,9,11-15 and 17-19* is/are pending in the application.

4a) Of the above claim(s) *17-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8,9 and 11* is/are rejected.

7)☒ Claim(s) *12-15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02/28/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-6, 8, 9, 11-15, and 17-19 are pending in the instant application. Claims 7, 10 and 16 were cancelled by amendment filed on December 1, 2008. Claims 17-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected subject matter. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other. Claims 1-6, 8, 9, and 11 are rejected. Claims 12-15 are objected.

Election/Restrictions and Amendment

The amendment to the claims filed on December 1, 2008 has been entered into the application.

Applicant's election with traverse of Group I, claims 1-5, 8 and 11-14, and the species I-a-1 has been acknowledged. The traversal is on the ground(s): "Elected Group I contains claims drawn to specific compounds, pesticides and/or herbicides and compositions of formula I. Group II is drawn to a process of preparing the compounds of Group I. Group III is drawn to a method of using the compounds of Group I. Groups I, II and III therefore share unity of invention because the special technical feature common to all the claims in the groups is the compounds of Group I. Applicants therefore respectfully assert that the Groups I, II and III share unity of invention and the Restriction Requirement is improper." This is found to be fully persuasive and Groups II and III have been rejoined to the elected Group I. The requirement is elect a single

disclosed species has been withdrawn (i.e. claims 1-6, 8, 9, and 11-15 has been examined in their entirety). The restriction (i.e. lack of unity) of Groups IV, V and VI is still considered proper, however, and is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

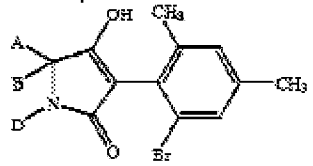
The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,994,274.

Determining the scope and contents of the prior art
U.S. Patent No. 5,994,274 discloses compounds of formula (I) (abstract), such as the compound of the formula (column 45, Table 4-continued)



wherein A and B is –(CH2)2-O-(CH2)2- and D is H (line 44). U.S. Patent No. 5,994,274 also discloses that this compound can be produced by the process disclosed in claim 5 and can be used in pesticidal and herbicidal compositions (claims 6 and 8) to combat unwanted pests and vegetation (claims 7 and 9).

Ascertaining the differences between the prior art and the claims at issue
The only difference between the compound disclosed in U.S. Patent No. 5,994,274 and the elected compound (i.e. I-a-1) of the instant claims is that the elected compound has ethyl is the Z position whereas the compound disclosed in U.S. Patent No. 5,994,274 (column 45, line 44) has a methyl.

Establishing a prima facie case of obviousness
To those skilled in the chemical art, one homologue is not an advance over an adjacent member of a homologous series. The reason for this is that one of ordinary skill, knowing the properties of one member of a series, would know what properties to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). In re Wood, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In re Lohr, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963).

Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to make the modification necessary to arrive at the elected compound (i.e. I-a-1) of the instant claims with a reasonable expectation of success for obtaining a compound with the same activity (i.e. can be used in pesticidal and herbicidal compositions). This is especially true since the compounds of U.S. Patent No. 5,994,274 are used for the same purpose as the compound(s) of the instant claims (i.e. to combat unwanted pests and vegetation).

Therefore, a *prima facie* case of obviousness has been established.

Double Patenting

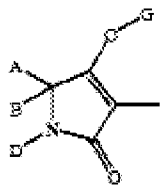
The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 8, 9, and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,994,274. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

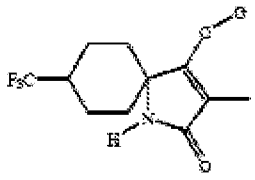
U.S. Patent No. 5,994,274 discloses (i.e. claim 1) compounds of formula (I)



wherein X is alkyl, Y can be alkyl, Z can be halogen, Het can be , and A and B, together with the carbon atom to which they are bonded, represent a saturated or unsaturated, optionally substituted carbocycle or heterocycle. Compounds of this

formula anticipate compounds of the instant claims. U.S. Patent No. 5,994,274 also discloses the same process of making compounds of formula (I) (i.e. claim 5) as in the instant claims as well as the same methods of using the compounds. Therefore, it would have been obvious to one of ordinary skill in the art to make the compounds of the instant claims given U.S. Patent No. 5,994,274 and to use them in pesticides and/or herbicides for controlling animal pests and/or unwanted vegetation.

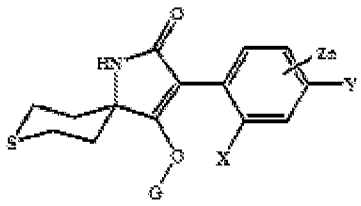
Claims 1-6, 8, 9, and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 12-21 of U.S. Patent No. 6,861,391. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

U.S. Patent No. 6,861,391 discloses a compound of formula (I) (i.e. claim 1) wherein V and Z can be hydrogen, X can be halogen, Y can be alkyl, W can be alkyl, and Het can be  . This compound anticipates compounds of the instant claims wherein A and B together with the carbon atom to which they are attached represent a saturated C6-ring which is substituted by haloalkyl. U.S. Patent No. 6,861,391 also discloses (i.e. claims 5 and 15-21) the same process of making the compounds as disclosed in the instant claims, the same process of making a pesticide and weed killer, and the same method of using the compounds. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make

the compounds, pesticides and/or herbicides of the instant invention given U.S. Patent No. 6,861,391 and to use them to control pests and/or unwanted vegetation.

Claims 1-5, 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,555,567. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

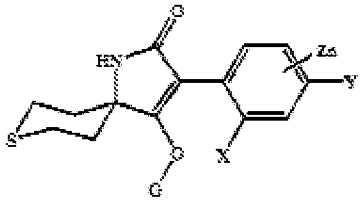
U.S. Patent No. 6,555,567 discloses (i.e. claim 1) compounds of formula

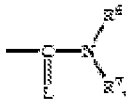


wherein Z can be halogen, n can be 1, Y can be C1-C6-alkyl, and X can be C1-C6-alkyl and these compounds anticipate compounds of the instant claims. U.S. Patent No. 6,555,567 also discloses that these compounds can be used in arthropodicidal or nematicidal compositions to combat arthropods or nematods. Therefore, it would have been obvious to one or ordinary skill to make the compounds of the instant claims given U.S. Patent No. 6,555,567 and to use those compounds in pesticides and in a method for controlling animal pests.

Claims 1-4, 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,479,489. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

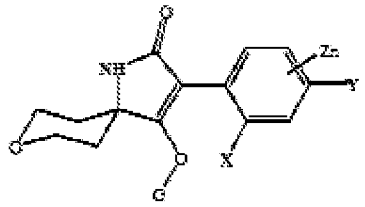
U.S. Patent No. 6,479,489 discloses (i.e. claim 1) compounds of formula



wherein G represents  and these compounds anticipate compounds of the instant claims wherein G is (g). U.S. Patent No. 6,479,489 also discloses that these compounds can be used in arthropodicidal or nematicidal compositions to combat arthropods or nematods. Therefore, it would have been obvious to one or ordinary skill to make the compounds of the instant claims given U.S. Patent No. 6,479,489 and to use those compounds in pesticides and in a method for controlling animal pests.

Claims 1-5, 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5 and 6 of U.S. Patent No. 5,981,567. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

U.S. Patent No. 5,981,567 discloses (i.e. claim 1) compounds of formula



wherein Z can be halogen, n can be 1, Y can be C1-C6-alkyl, and X can be C1-C6-alkyl and these compounds anticipate compounds of the instant claims. U.S. Patent No. 5,981,567 also discloses that these compounds can be used in an arthropodicidal or nematicidal composition and in a method to combat

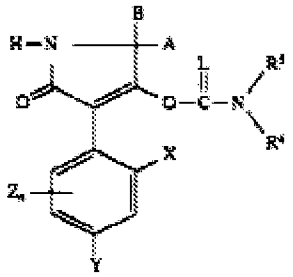
arthropods or nematods. Therefore, it would have been obvious to one or ordinary skill to make the compounds of the instant claims given U.S. Patent No. 5,981,567 and to use those compounds in pesticides and in a method for controlling animal pests.

Claims 1-5, 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 7, and 8 of U.S. Patent No. 6,358,887. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

U.S. Patent No. 6,358,887 discloses compounds of formula (I) (i.e. claim 1) wherein X can be halogen, Y can be C1-C6-alkyl and Z can be C1-C6-alkyl and compounds of this formula anticipate compounds of the instant claims. U.S. Patent No. 6,358,887 also discloses methods of combating pests and weeds. Therefore, it would have been obvious to one or ordinary skill to make the compounds of the instant claims given U.S. Patent No. 6,358,887 and to use those compounds in pesticides and/or herbicides in a method for controlling animal pests and/or unwanted vegetation.

Claims 1-4, 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 7 and 8 of U.S. Patent No. 5,616,536. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

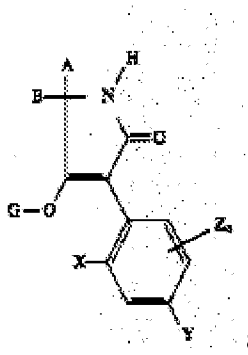
U.S. Patent No. 5,616,536 discloses (i.e. claim 1) compounds of formula



and these compounds anticipate compounds of the instant claims wherein G is (g). U.S. Patent No. 5,616,536 also discloses that these compounds can be used in an insecticidal, acaricidal or herbicidal composition to combat insects, acarids or unwanted vegetation. Therefore, it would have been obvious to one or ordinary skill to make the compounds of the instant claims given U.S. Patent No. 5,616,536 and to use those compounds in pesticides and/or herbicides and in a method for controlling animal pests and/or unwanted vegetation.

Claims 1-5, 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,462,913. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

U.S. Patent No. 5,462,913 discloses (i.e. claim 1) compounds of the formula



and these compounds anticipate compounds of the instant claims. U.S. Patent No. 5,462,913 also discloses that these compounds can be used in an

pesticidal, arthropodicidal, nematicidal or herbicidal composition and in a method to combat pests. Therefore, it would have been obvious to one or ordinary skill to make the compounds of the instant claims given U.S. Patent No. 5,462,913 and to use those compounds in pesticides and/or herbicides and in a method for controlling animal pests and/or unwanted vegetation.

Claim Objections

Claims 12-15 are objected for depending on a rejected base claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIN BIANCHI whose telephone number is (571)270-5232. The examiner can normally be reached on Mon-Fri 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed/
Primary Examiner, Art Unit 1626

Kristin Bianchi
Examiner
Art Unit 1626

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